

REMARKS

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

By the foregoing amendment, claim 12 has been canceled. Claim 11 has been amended to incorporate the features of claim 12. Further, claims 16 and 18 have been amended in response to objections raised in the Office Action. Claims 11 and 13-21 remain pending in the application.

The specification has been amended to correct obvious errors. It is clear from the data in Table 3 that Examples Y1-3 and Y1-4 are comparative Examples since they use ethylene homopolymer in the graft copolymer rather than ethylene/l-butene copolymer.

The title was objected to for the reason set forth in paragraph 2 of the Office Action. In this regard, Applicants note that the word "Obtained" in the original title was removed when the title was amended in the Preliminary Amendment filed October 20, 2004. Applicants note, however, that the official Filing Receipt incorrectly spells the word "Obtained." Accordingly, Applicants are filing concurrently herewith a Request for Corrected Official Filing Receipt.

Claim 16 was objected to for the reasons set forth in paragraph 3 of the Office Action, and claim 18 was objected to for the reason set forth in paragraph 4 of the Office Action. Withdrawal of these objections is respectfully requested in view of the above amendments and the following remarks.

Claim 16 has been amended to add alternative language. Claim 18 has been amended to properly depend from claim 16.

In view of the above, the objections to claims 16 and 18 have been obviated and should be withdrawn.

Claims 11-15 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent Document No. 10-237237 (Masato) for the reasons set forth in paragraph (6) of the Office Action. Reconsideration and withdrawal of these rejections are requested for at least the following reasons.

JP '237 (Masato) discloses a flame-retardant resin composition comprising (A) an ethylene/ α -olefin copolymer, (B) a graft-modified polyolefin with an acid anhydride and (C) magnesium hydroxide having a specific property. JP '237 further discloses in the working examples an ethylene/ α -olefin copolymer which has a density of 0.902 g/cm³ and a graft-modified linear low density polyethylene (LLDPE) with maleic anhydride having a density of 0.92 g/cm³.

Thus, JP '237 does not disclose a composition containing an ethylene/ α -olefin copolymer and a graft-modified ethylene copolymer, both having a density of 857 to 890 kg/m³ as now defined in claim 11. Also, JP '237 is silent with respect to the use of a graft-modified ethylene copolymer having the specified density which provides compositions having increased scratch resistance and excellent break strength and elongation at break as shown in Table 3 of the specification. The compositions are pliable and flexible which makes them quite suitable for coating electric wires.

In the Office Action, the Examiner argues that the density, melt flow rate and index (Mw/Mn) are inherently possessed by the graft-modified ethylene polymer disclosed in the reference. Respectfully, Applicants disagree.

To support a rejection based on inherency, the Examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the disclosures of the prior art. It is well established that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir.

1993). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).” “In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. of Pat. Apps. & Inter. 1990).” Note M.P.E.P. §2112.

Thus, inherency must flow as a necessary conclusion from the prior art, not simply a possible one. Applicants respectfully submit that there is no basis in fact and/or technical reasoning to reasonably support a conclusion that the allegedly inherent properties necessarily flow from the disclosure of the reference.

In view of the above, the §102 rejection over Masato '237 should be withdrawn. Such action is earnestly solicited.

Claims 16-21 were rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,232,377 (Hayashi et al) in view of U.S. Patent No. 4,913,965 (Keogh) for the reasons set forth in paragraph (9) of the Official Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

Hayashi et al '377 discloses flame retardant compositions containing specified ingredients (A) through (F); note the Abstract. However, as acknowledged in the Office Action, this document fails to disclose component (F) in present claim 16.

Keogh '965 discloses flame retardant compositions which may contain reinforcing additives having at least two polymerizable unsaturated groups. The lengthy list of suitable

reinforcing additives in column 3 of this Patent includes unsaturated esters of polyhydric alcohols such as pentaerythritol.

Thus, the reinforcing additives disclosed in Keogh '965 are polyhydric alcohol esters as opposed to the polyhydric alcohol ingredient (F) in claim 16. Moreover, the combination of polyhydric alcohol and triazine ring-containing compound provides unexpected results. The compositions in Example Z4 (Table 4, page 39 of the specification) includes melamine cyanurate in an amount of 15 parts by weight (pbw) and pentaerythritol in an amount of 5 pbw (total of 20 pbw). In Comparative Example Z9, melamine cyanurate is present in an amount of 30 pbw and in Comparative Example Z10, pentaerythritol is present in an amount of 30 pbw. It is clear from comparing the data in Examples Z4 with that of Comparative Examples Z9 and Z10, that the combination of melamine cyanurate and pentaerythritol yields compositions having improved flame retardancy (i.e., satisfied two of the three conditions on page 38) in comparison to melamine cyanurate alone (Z9) or pentaerythritol alone (Z10) (satisfied only one of the conditions). These results could not have been predicted from the disclosures of the cited references.

In view of the above, the §103 rejection over Hayashi et al '377 in view of Keogh '965 should be withdrawn. Such action is earnestly solicited.

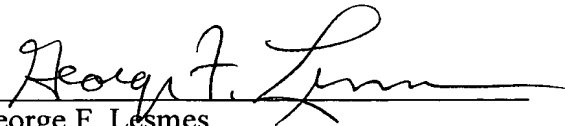
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any

questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at her earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: October 12, 2005

By: 
George F. Lesmes
Registration No. 19,995

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620